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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,392

07/03/2003

Ronald J. Rosenberger

7234

77079

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12/03/2008

Guy Kevin Townsend
197 Sayre Drive
Princeton, NJ 08540

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

12/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 August 2008 has been entered.

Supplemental Amendment

2. Applicant filed a supplemental amendment on 13 August 2008. The Office may enter a supplemental amendment only if it is "clearly limited to" one or more of six criteria (A)-(F) given in 37 CFR § 1.111(a)(2). The supplemental amendment adds claims, which does not comply with any of the six criteria. Hence, the supplemental amendment has not been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 2, 4-6, 14, 15, 20 and 43-50 are rejected under 35 U.S.C. 101 because the claimed invention is not directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35 U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform a particular article into a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 70 (1972); *Diamond v. Diehr*, 450 U.S. 192 (1981); *Parker v. Flook*, 437 U.S. 589 n.9 (1978); and *Cochrane v. Deener*, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patentability (*Benson*, 409 U.S. 71-72). The involvement of the machine or transformation must not merely be insignificant extra-solution activity (*Flook*, 437 U.S. 590).

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5. The instant claims fail to meet this test. The claims fail to transform a particular article into a different state or thing. The claims are tied to a machine or apparatus, a "computer readable medium" (claim 1 line 5), but this does not does not qualify as a *specific* machine and does not impose a *meaningful* limitation. This rejection also applies to claims 43-50, which, while drawn nominally to a "system", have no structure other than that provided by recitation of the corresponding process claim steps.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 4-6, 14, 15, 20 and 43-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The distinction between "promoter" and "offering entity" (e.g., at claim 1, 3rd line from the end) is indefinite. Furthermore, a "third party" (e.g., at claims 2 and 44) and a "primary advertising entity" (e.g., at col. 6 and 47) are also indefinite.
8. The claimed promoter, third party and the entities are interpreted to be distinguished by ownership. Ownership is inherently indefinite because it is itself not concrete (predictable) and precludes a result which is not concrete. The US Supreme Court has ruled that "A corporation is an artificial being, invisible, intangible and existing only in contemplation of law." *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). A business entity can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership language cannot impart patentability.
9. Claims 1, 2, 4-6, 14, 15, 20 and 43-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "said account applications" (col. 1 item "d" and col. 44 item "iv") lacks antecedent basis.

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10. Claims 4, 5, 15, 45, 46 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4, 5, 15, 45, 46 and 49 each contain an improper Markush group (MPEP § 2173.05(h)I).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 4-6, 14, 15, 20 and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manchester et al (US 20030204470A1, hereafter "Manchester").

13. Manchester teaches (independent claims 1 and 43) a system and method, the method comprising:

(d. and e.) distributing credit card applications containing (comprising) a promoter code (*merchant number*) to users, and processing completed/redeemed applications comprising said promoter code/*merchant number* (para. [0017] and [0018]);

f. establishing said accounts for said end users (*issues the credit card 16 to the applicant*) based on said processing of said redeemed account applications comprising said promoter code (para. [0017]); and

g. issuing communications to said end users of said accounts (*merchant promotional material*, para. [0012], and *provide marketing information*, para. [0024]) where said communications comprise said file information comprising said advertisements, as referenced by said promoter coding information,

where said communications/advertisements inherently reads on (a.) providing a file comprising said advertisements for said promoter.

14. Manchester does not teach (b.) storing said file on a computer readable medium and (c.) providing a promoter code that cross references said promoter code to said file information

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on a computer readable medium. However, under *KSR v. Teleflex* (82 USPQ 2nd 1385), it would have been obvious to add these features to the teachings of Manchester because prior art elements are being combined according to known methods to yield predictable results. Manchester teaches every feature of the claims except storing said ad files on a computer readable medium cross-referenced to the promoter code. The cross-reference to the promoter code is obvious, and indeed necessary, in order to send the correct ad to the promoter's customers. Putting the ad on a computer readable medium was an obvious, and again virtually necessary step at the time of the instant invention, in order to print or display the ad with the customer statements.

15. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“wherein said promoter (i) is not said offering entity, (ii) does not provide financial cards for purchase of products or services provided by said promoter, or (iii) does not co-brand a financial card with said offering entity merchant.”

In the sense used in the patent law (35 USC 101), the relationship between the “promoter” and the “offering entity” is not functional because it is neither “tied to a particular apparatus” nor “operates to change materials to ‘a different state or thing’” (*IN RE COMISKEY*, CAFC 2006-1286, September 2007).

16. For the same reason, no patentable weight was given to “third party” (claims 2 and 44; the Internet is taught at para. [0018]) or to “third-party advertising entity” (claims 6 and 47, where the promoter/*merchant* reads on “a primary advertising entity”)
17. Manchester also teaches claims 4, 5, 45 and 46 at the citations given above. For claims 14, 20, 48 and 50, the ads belong to the promoter so it is obvious that the promoter would decide what goes into the ads and how long they should run. The fees (claims 15 and 49) would be obvious when the offering entity provided said file maintenance services to the promoter.

Response to Arguments

18. Applicant's arguments filed 12 August 2008 have been fully considered but they are moot in view of the new bases of rejection.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
20. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

29 November 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688